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P1 IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Sususmu SEINO et al.

Serial No. : 09/617,099

Group Art Unit : 1653

Filed : July 14, 2000

Examiner : Rita Mitra

For : PROTEIN RIM2

### ELECTION WITH TRAVERSE

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Sir:

This paper is responsive to the Requirement for Restriction mailed from the Patent and Trademark Office October 1, 2001 (Paper No. 7), in the above application and setting a one-month period for response thereto which runs through November 1, 2001. Inasmuch as this response is being filed within the one-month period for response, it is believed that no extension of time is required. However, if an extension of time is deemed by the Patent and Trademark Office to be necessary, the same is hereby requested and the Patent and Trademark Office is authorized to charge any extension of time fees and any other fees necessary for maintaining the pendency of this application to deposit account No. 19-0089.

**Summary of Restriction Requirement**

The Restriction Requirement states that the Examiner has determined that five distinct inventions are contained in this application, namely:

- I) Claims 1 and 2, drawn to a protein having the amino acid sequence set forth in SEQ ID NO: 1 and variants thereof; classified in Class 530, subclass 350; and
- II) Claims 3-12, drawn to a gene, DNA having nucleotide sequence set forth in SEQ ID NO: 2, encoding a protein having amino acid sequence of SEQ ID NO: 1, variants and fragments thereof, probe, primer, vector; classified in Class 536, subclasses 23.5, 24.3, 24.32; Class 435, subclasses 69.1, 252.3, and 320.1; and
- III) Claim 13, drawn to an antibody, directed to a protein set forth in SEQ ID NO: 1; classified in Class 530, subclass 387.1, Class 424, subclass 130.1; and
- IV) Claim 14, drawn to a diagnostic agent for secretory disorders, comprising the probe of claim 9; classified in Class 536, subclass 23.1, 24.3, 24.32, Class 435, subclass 6; and
- V) Claim 15, drawn to a diagnostic agent for secretory disorders, comprising the antibody of claim 13; classified in Class 530, subclass 387.1; and Class 435, subclass 7.1.

The Examiner has therefore required that an election be made between these inventions.

**Election**

In order to be responsive to the Restriction Requirement, Applicants elect the invention of Group II (claims 3-12), with traverse.

**Traverse**

Applicant submits that a restriction is inappropriate in this case and should be withdrawn.

Initially, Applicants note that the Restriction indicates that Group I is directed to a protein (claims 1-2) and that Group II is directed to DNA encoding the same protein, or fragments thereof (claims 3-12), and Group IV (claim 14) is directed to a diagnostic agent comprising a fragment of Group II DNA encoding the Group I protein . Applicants submit that a restriction is especially inappropriate in this case because there is no serious search burden. In MPEP Chapter 800, the Office sets forth its policy by which examiners are guided in requiring restriction under 35 U.S.C. §121. Section 803 states that "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."

Although Groups I, II and IV differ in that Group I is directed to a protein and Groups II and IV are directed to DNA sequences encoding the very same protein, the underlying concepts are quite similar. Thus, a search for the DNA of Groups II and IV should cover areas relevant to the protein of Group I. In other words, for examination purposes, if a search area were relevant to the DNA sequences of Groups II and IV, it would also be relevant to the amino acid sequence of Group I. Conversely, if a search area were relevant to Group I, it would be relevant to Group II. Therefore, as a practical matter, the searches for the Groups should significantly overlap. Thus, the search burden would not be serious.

P19771.A08

In addition, Groups I, III and V differ in that Group I is directed to a protein and Groups III and V are directed to antibodies for the same protein. Thus, a search for the antibodies of Groups III and V should cover areas relevant to the protein of Group I. In other words, for examination purposes, if a search area were relevant to the antibodies, specific for a protein, of Groups III and V, it would also be relevant to the very same protein of Group I. Conversely, if a search area were relevant to Group I, it would be relevant to Group III and V. Therefore, as a practical matter, the searches for the Groups should significantly overlap and the search burden would not be serious.

In this regard, the searches for the Species should significantly overlap, and the search burden would not be serious.

Furthermore, as the Examiner appreciates, in order to justify a requirement for restriction the difference between the invention defined by the various groups of the claims must be material. Despite this requirement, although the Examiner has characterized the noted difference as being material, the Examiner has not stated or offered a definition of what is "materially different" to justify a requirement for restriction, or offered an explanation as to why the mentioned differences are material for restriction requirement purposes.

Absent an explanation of this concept, it is respectfully submitted that the Examiner has not explained how such a difference is sufficiently "materially different" so as to justify the Restriction. With regard to the Restriction, the Examiner has merely stated that the Groups are unrelated because they are not disclosed as capable of use together and they have different modes of operations, different functions or different effects. However, the claims are not directed to the functionality, but

P19771.A08

to compositions of nature which are closely related to each other by functionality. The DNA sequences encode the amino acid sequence which is bound by the antibody. Therefore, the inventions defeats are not distinct, but are instead related and linked together.

It is also important for the Examiner to understand that Applicants have paid a filing fee for an examination of all the claims in this application. If, however, the Examiner refuses to examine all the claims paid for when filing this application and persists in requiring Applicants to file divisional applications for each group of claims, the Examiner is essentially forcing Applicants to pay duplicative fees for the non-elected or withdrawn claims.

Therefore, Applicants respectfully request that the Restriction requirement be reconsidered and withdrawn, in view of the lack of a serious burden, and the lack of material differences between the Groups.

If the Examiner has any questions concerning this matter or the application, the undersigned can be contacted at the below-listed telephone number.

Respectfully submitted,  
Susumu SEINO et al.



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Attorney Docket No. P19771

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THE COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

Sir:

Transmitted herewith is an election with traverse in the above-captioned application.

- ☒ Small Entity Status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a verified statement previously filed.  
☐ A verified statement to establish small entity status under 37 C.F.R. 1.9 and 1.27 is enclosed.  
☐ A Request for Extension of Time.  
☒ No additional fee is required.

The fee has been calculated as shown below:

Claims After Amendment	No. Claims Previously Paid For	Present Extra	Small Entity		Other Than A Small Entity	
			Rate	Fee	Rate	Fee
Total Claims: 15	*20	0	x 9=	\$	x 18=	\$0.00
Indep. Claims: 2	**3	0	x 42=	\$	x 84=	\$0.00
Multiple Dependent Claims Presented			+140=	\$	+280=	\$0.00
Extension Fees for Month				\$		\$0.00
Total:				\$	Total:	\$0.00

\*If less than 20, write 20

\*\*If less than 3, write 3

☐ Please charge my Deposit Account No. 19-0089 in the amount of \$\_\_\_\_\_.

N/A A Check in the amount of \$\_\_\_\_\_ to cover the filing/extension fee is included.

☒ The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-0089.

☒ Any additional filing fees required under 37 C.F.R. 1.16.

☒ Any patent application processing fees under 37 C.F.R. 1.17, including any required extension of time fees in any concurrent or future reply requiring a petition for extension of time for its timely submission (37 CFR 1.136) (a)(3)

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